



Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Integrity IP  
P.O. Box 757  
La Jolla, CA 92038

In re Application of  
Joseph Florian  
Application No. 10/780,813  
Filed: February 17, 2004  
Attorney Docket No. 263.1  
Title: OPTICAL IN-VIVO MONITORING  
SYSTEMS

**Renewed Petition  
Under 37 CFR §1.181(a)**

### **Background**

Applicants have received Decision on Petition (herein Decision) dated August 6, 2007 signed by Senior Attorney Paul Shanowski, copy appended hereto. The decision suggests a renewed petition and this response is in answer to that suggestion.

The decision correctly sets forth the background with regard to the notice of missing parts (notice) mailed May 12, 2004. Further, it is correctly described that no extensions of time were requested - as a timely response was in fact duly filed submitted in accordance with 37 CFR §1.8 (b). It is now clear that response was never received in the Office. While the decision alleges that "no response was received", Applicant had no knowledge of this and all the time up to January 2007 remained unaware of that.

### **Presentation**

Examiner indicates a Notice of Abandonment mailed February 9, 2005. This notice was not received by Applicant nor Applicant's counsel, and none arrived at the address of record. While Applicant's counsel's telephone number is on record and has at all times since original filing been operational, the office has not contacted Applicant's counsel by telephone. While it is acknowledged that a phone call is not necessarily mandated by MPEP, a courtesy telephone call

may have prevented entirely this entire action. Conversely, Examiners taking this extra step have enjoyed quick resolution to similar issues. Applicants are entitled benefit from efficient office procedures at the United States Patent and Trademark Office.

In the **Analysis** section of the decision, it is written: "*petitioner has effectively alleged the holding of abandonment should be withdrawn because a response to the notice was purportedly timely filed. Petitioner has not set forth on what date this response was purportedly submitted to the office*". It is understandable indeed that a petition be denied where Applicant has *not* provided such date as described – and this likely is the reason reviewer has denied the petition at bar. However, contrary to the reviewer's statement, *the dates a response was timely filed is well documented in the file*. The response including: 1) a Certificate of Mailing (dated June 15, 2004); 2) missing parts response letter (two pages dated June 15, 2004); 3) fee transmittal; and check in the amount of \$450 also dated June 15, 2004, all are clearly indicative of the date of the filing.

In addition, and as a reserve form of payment; a paper fashioned as "deposit account general authorization" and dated June 15, 2004 was also submitted as part of the response.

Contrary to reviewer's position (probably made in error), the original response did in fact include the requisite mailing certificate. Review is requested to again check the file in the office as it is believed this mailing certificate will be found there.

Applicants do in fact assert that each of these items was submitted to the office on June 15, 2004. Further, Applicants assert these were timely submitted in strict accordance with 37 CFR §1.8. As such, on this point alone, applicant is entitled reinstatement of the case. The pertinent section reads:

...will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1)Correspondence will be considered as being timely filed if:

(i)The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A)Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;

(B)Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); or

(C) Transmitted via the Office electronic filing system in accordance with § 1.6(a)(4); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

In agreement with § 1.8 (b) (1), Applicant has informed the office of the previous mailing *promptly after becoming aware* that the office had no evidence of receipt of the correspondence. In agreement with 37 CFR § 1.8 (b) (2) Applicant did supply the Office on January 15, 2007 an additional copy of the previously mailed correspondence *and Certificate of Mailing*.

In agreement with CFR § 1.8 (b) (3), Applicant did include a statement which attests in a personal knowledge basis to the previous timely mailing. The Notice of Mailing filed January 15, 2007 includes requisite statement.

While the Office may require additional evidence to determine if the correspondence was timely filed, none has been requested. Section § 1.8 does not impose a time limit upon Applicant other than "promptly after becoming aware".

Applicant only became aware of abandonment in January 2007. In an Internet search under belief the application was pending in good order, Applicant first became informed of the abandonment. Applicant is prepared to swear out an affidavit to that effect if the office suggests this improves the timeliness of this Petition to Revive.

Reviewer states on page 3 "the original papers have not been located". But this is in agreement with Applicant having filed the Notice of Mailing -with a copy of the earlier correspondence. Applicant is now fully aware the file does not include the original papers and the proper remedy for that is the Notice of Mailing under 37 CFR § 1.8 (b) – precisely Applicant's response.

Reviewer repeats the assertion that papers submitted on June 15, 2004 did not appear to contain a Certificate of Mailing. This is surely in error. The Notice of Mailing includes a clear

copy of that certificate, and in addition includes the statement on personal knowledge the mail was made in accordance with 37 CFR §1.8. – i.e. with a Certificate of Mailing. Yet another copy enclosed herewith, however Applicant is confident another review of the file in the office will show the Certificate of Mailing filed June 15, 2004 copy provided January 15, 2007, is in the file. Petitions Reviewing Attorney twice mentions the certificate was omitted, however Applicants believe this must be in error. Review and reconsideration is requested.

Petitions Reviewing Attorney further notes that "it does not appear" that a postcard receipt has been provided. Section §1.8 (b) does not provide for use of such postcard receipts. While postcard receipts are desirable and useful for certain mailing transactions, 37 CFR 1.8 (b) explicitly omits any mention of them in Notice of Mailing procedures.

In final comments, Applicants only became aware of the abandonment in January 2007 and did not have any knowledge or belief other than a normally pending application awaiting first examination. It is certainly normal business to receive a first examination more than 24 months after filing. Applicants take exception to the suggestion that application was intentionally abandoned and hereby explicitly and categorically reject that position. The application was not intentionally abandoned.

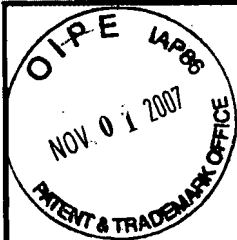
In view of completeness in addressing reviewers entire Decision, it is noted that Reviewer is correct in mentioning that the check has no case identifier indicated. It is not now and has not ever been normal practice to provide such indicators on cases from our office. Many hundreds of previously submitted checks have been accounted for without error in identical fashion. Sample copies of such checks will be made available should the Office deem it helpful. Further instruction in this regard is solicited.

Respectfully Submitted

A handwritten signature in black ink, appearing to read 'Joseph Page', with a long horizontal flourish extending to the right.

Joseph Page

#35,311



In Re: Florian, J.

Serial Number 10/780,813

**Certificate of Mailing under 37 CFR 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents  
Washington, D.C. 20231

on Jun 15, 2004  
Date

  
\_\_\_\_\_  
Signature

Joseph Page

\_\_\_\_\_  
Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Missing Parts Response Letter

New Fee Transmittal

Deposit Account Gen. Auth.

Check

Copy of Notice to File Missing F



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
WWW.USPTO.GOV



*Copy*

Paper No. None

INTEGRITY IP  
P.O. BOX 757  
LA JOLLA CA 92038

**COPY MAILED**

AUG 06 2007

**OFFICE OF PETITIONS**

In re Application of	:	
Joseph Florian	:	
Application No. 10/780,813	:	DECISION ON PETITION
Filed: February 17, 2004	:	UNDER 37 C.F.R. §§ 1.181(A)
Attorney Docket No.: 263.1	:	
Title: OPTICAL IN-VIVO	:	
MONITORING SYSTEMS	:	

This is a decision on the "notice of mailing under 37 CFR §1.8(b)," which is properly treated as a petition filed on January 22, 2007, pursuant to 37 C.F.R. § 1.181(a).

For future reference, Petitioner should consider clearly labeling such a submission as a petition under Rule §1.181, so that the filing may be properly routed to the Office of Petitions for consideration.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Missing Parts (notice), mailed May 12, 2004, which set a shortened statutory period for reply of two months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified

application became abandoned on July 13, 2004. A notice of abandonment was mailed on February 9, 2005.

RELEVANT PORTIONS OF THE C.F.R. AND M.P.E.P.

37 C.F.R. § 1.8(b) sets forth, in toto:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

M.P.E.P. § 503 sets forth, in pertinent part:

If a receipt for any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. To ensure the receipt of return receipt postcards, users must either: (A) purchase already stamped postcards from the United States Postal Service (USPS) or affix postage stamps to their postcards; or (B) if a postage meter is used, ensure that the meter postmark does not show the date. Any return receipt postcard containing a dated meter postmark may not be delivered by the USPS to the address provided on the postcard. >Users are reminded that they are solely responsible for placing the proper postage on self-addressed postcards that are submitted to the USPTO for the purpose of obtaining a receipt for correspondence being filed in the USPTO. Users should check with the USPS regarding postage and what size cards are acceptable to the USPS. Any return receipt postcard that does not contain sufficient postage or is not acceptable may not be delivered by the USPS to the address provided on the postcard, and, if returned to the USPTO, may be discarded.

The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

ANALYSIS

With the present petition, Petitioner has effectively alleged that the holding of abandonment should be withdrawn because a response to the notice was purportedly timely filed. Petitioner has not set forth on what date this response was purportedly submitted to the Office, but has indicated that a copy of the "mailing certificate" was enclosed with the present petition.

Petitioner has included a copy of a paper entitled "Missing Parts Response," along with a Fee Transmittal Sheet and a paper entitled "Deposit Account General Authorization." Each of these items is dated June 15, 2004, and neither appears to contain a certificate of mailing. Petitioner has further included a copy of a check in the amount of \$450 that is dated June 15, 2004.

It appears that Petitioner has attempted to assert that each of these items was submitted to the Office on June 15, 2004.

The electronic file has been reviewed, and the original papers have not been located. Furthermore, Office records do not indicate the receipt of \$450 on or about June 15, 2004. A copy of the "mailing certificate" has not been located either.

37 C.F.R. §1.8 and M.P.E.P. §503 set forth procedures which may be undertaken by applicants, in order to provide relief and secure the withdrawal of a holding of abandonment in situations where a communication is mailed to the Office and either not received or misplaced within the same.

Petitioner has included copies of the papers that were purportedly submitted to the Office on June 15, 2004, and neither appears to contain a certificate of mailing. Moreover, it does not appear that a postcard receipt has been provided with this petition.

It follows that the showing in the present petition is not sufficient to withdraw the holding of abandonment. Pursuant to the discussion above, the petition pursuant to 37 C.F.R. §1.181 must be DISMISSED.

Furthermore, it is noted that almost two years passed between the mailing of the notice of abandonment and the filing of the present petition.

It is not clear why the Applicant chose to take no course of action for such a long period of time. It does not appear that the Applicant took any action to further the prosecution of this application. It is equally unclear what, after all of this time, prompted the Applicant to advance the prosecution of this application. As such, it appears that Applicant intentionally



allowed this application to stay abandoned for such a long period of time. Any subsequent filing must address both Applicant's extended period of inaction as well as the decision to file this petition after two years had passed, and must include a statement of facts from one having firsthand knowledge of the facts set forth therein.

It is noted in passing that the copy of the check has been reviewed, and it does not appear to contain an identifier that would associate it with the present application, such as an application number or an attorney docket number.

#### CONCLUSION

Any reply must be submitted within TWO MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail<sup>1</sup>, hand-delivery<sup>2</sup>, or facsimile<sup>3</sup>. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web<sup>4</sup>.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§1.137(a) and/or (b). Petitioner may download information about these petitions here:  
[http://www.uspto.gov/web/offices/pac/mpep/documents/0700\\_711\\_03\\_c.htm#sect711.03c](http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

Telephone inquiries regarding this decision should be directed

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1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.  
2 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.  
3 (571) 273-8300- please note this is a central facsimile number.  
4 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

to the undersigned at (571) 272-3225<sup>5</sup>. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski  
Senior Attorney  
Office of Petitions  
United States Patent and Trademark Office

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<sup>5</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.